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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/019,195	06/03/2002	Hans-Jurgen Hannig	09646-00004	6251
25223	7590	09/09/2004	EXAMINER	
WHITEFORD, TAYLOR & PRESTON, LLP ATTN: GREGORY M STONE SEVEN SAINT PAUL STREET BALTIMORE, MD 21202-1626				GARCIA, ERNESTO
ART UNIT		PAPER NUMBER		
		3679		

DATE MAILED: 09/09/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/019,195	HANNIG ET AL.	
	Examiner Ernesto Garcia	Art Unit 3679	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 16 June 2004.
- 2a) This action is **FINAL**. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-9 and 21-32 is/are pending in the application.
- 4a) Of the above claim(s) 6,7,9,21-28 and 32 is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-5,8 and 29-31 is/are rejected.
- 7) Claim(s) 38,31 is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 16 June 2004 is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
 Paper No(s)/Mail Date _____
- 4) Interview Summary (PTO-413)
 Paper No(s)/Mail Date. _____
- 5) Notice of Informal Patent Application (PTO-152)
- 6) Other: _____

DETAILED ACTION

Election/Restrictions

Claims 6, 7, 9, 21-28 and 32 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected species, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in Paper No. 12. Regarding claim 32, since claim 9 is withdrawn and claim 32 depends from withdrawn claim 9, claim 32 inherently is withdrawn.

In response to applicant's remarks about the restriction, applicant is reminded that claim 1 no longer links species shown in Figure 2 and Figure 3. Therefore, applicant should note the following from Annex B of the MPEP: If, however, an independent claim does not avoid the prior art, then the question whether there is still an inventive link between all the claims dependent on that claim needs to be carefully considered. If there is no link remaining, an objection of lack of unity *a posteriori* (that is, arising only after assessment of the prior art) may be raised. Similar considerations apply in the case of a genus /species or combination /subcombination situation.

(iii) This method for determining whether unity of invention exists is intended to be applied even before the commencement of the international search.

Where a search of the prior art is made, an initial determination of unity of invention, based on the assumption that the claims avoid the prior art, may be reconsidered on the basis of the results of the search of the prior art.

Since a new search was conducted and a new art found, the applicant needs to pick a species for prosecution as there is no unity of invention between the two species and the independent claim does not avoid the prior art.

Specification

The disclosure is objected to because of the following informalities: throughout the specification, characters C1-C19, at the beginning of some paragraphs, appear to indicate reference characters and should be deleted from the specification as the characters do not serve any purpose. Appropriate correction is required.

Drawings

The drawings were received on 6/16/04. These drawings are not acceptable. Applicant has introduced a new drawing believing to show the narrow sides. As a result, the panel has the profiles 42, 43 in two parallel sides (the narrow sides) and profiles 4a, 4b in additional two parallel sides (the wide sides). The narrow sides are not placed correctly in proportion to the panel. The sides 65 and 66, ~~that~~ the applicant

labeled, are shown as the wide sides in respect to the panel. Proper correction is required.

The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because reference character "4" has been used to designate both a panel that has a hook projection 4f that makes a gap L1 with panel 5 (Fig. 2) and a panel that has a hook projection 4f that does not make a gap L1 with panel 5 (Fig. 3); reference character "5" has been used to designate both a panel that has a hook projection 5f that makes a gap L1 with panel 4 (Fig. 2) and a panel that has a hook projection 5f that does not make a gap L1 with panel 4 (Fig. 3); and reference character "12" shows a pocket that is enclosed and a pocket that is not enclosed (Figs 2 and 3). Applicant has admitted that Fig. 3 is another embodiment and argued that the panels are the same. This is not persuasive as the panels are not the same panels. Figure 3 is a different embodiment as indicated by applicant; thus, the panels are not the same. Note, when the same components are not shown the same, a prime or a letter follows the reference character to depict a different species (embodiment). The same, means identical dimensions, identical details, and a replica of the same component.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure

number of an amended drawing should not be labeled as "amended". If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the examiner does not accept the changes, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Objections

Claims 1-5, 8, 29 and 30 are objected to because of the following informalities:

regarding claims 1-5, 8 and 29, applicant should consider naming the panels as a first panel and a second panel from the beginning of claim 1 as claim 2 is already attempting to do so. Stating a first panel and a second panel will obviate a double inclusion problem and provide clarity throughout the claims;

regarding claim 2, --the-- needs to be inserted before "oppositely" in line 2, and --of the second retaining profile-- needs to be inserted after "leg" in line 13 to distinguish the leg from that of the first retaining profile;

regarding claim 8, "the" in line 1 needs to be deleted as "intermediate spaces" have not bee previously recited; and,

regarding claim 30, the subject matter of claim 1 should incorporated into claim 30 to place claim 30 in independent form. Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-8, 29, 30 and 31 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The claims are generally narrative and indefinite, failing to conform with current U.S. practice. They appear to be a literal translation into English from a foreign document and are replete with grammatical and idiomatic errors. The limitation "in such a way" in lines 4 and 11 is idiomatic. The limitation "with" in line 2 is a grammatical error as the panels have the retaining profiles and not the fastening system. Thus, it should read "the panels with retaining profiles", or preferably, "the panels having retaining profiles" to correspond to U.S. practice.

Regarding claim 1, the term "narrow" in line 2 is a relative term, which renders the claim indefinite. The term "narrow" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. In order for specifying narrow sides, wide sides needs to be recited, or a rectangular panel needs to be recited such that the narrow sides of the rectangular panel are inherently included thus providing proper relation to the wide sides.

Regarding claim 1, the meets and bounds of the claim is unclear. It is unclear what the fastening system comprises of. Furthermore, the preamble states that the fastening system is "for panels" yet the body of the claim positively states the panels as line 2 indicates the profiles are arranged at narrow sides of the panels. Applicant needs to state whether applicant is claiming the fastening system without the panels or in combination with the panels and present language consistent with the invention. Moreover, are the "retaining profiles" in line 2 the same profiles in the "oppositely disposed retaining profiles" of line 3? The reference characters in parenthesis of these components indicate to be the same thus a double inclusion of the components occurs. Furthermore, it is unclear whether applicant is claiming the "similar panels" in line 4. The limitation "the other" in line 7 is unclear what the other represents. The other what?

Regarding claim 2, the limitation "which projects from the narrow side" in line 5 is unclear whether the hook element or the leg projects from the narrow side.

Furthermore, it is unclear whether the feature that projects from the narrow side only occurs in one panel as the language "of the panel" in line 5 indicates one panel.

Regarding claim 8, the limitation "with clearance" in line 2 makes unclear whether this is another clearance than that recited in claim 3, or another clearance.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1, 2, 4 and 30 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 11, 14, 15, 24, 38-40, 45, 65, 66, and 71 of U.S. Patent No. 6,505,452. Although the conflicting claims are not identical, they are not patentably distinct from each other because it claims the retaining profiles, and the hook projection tapered thus the hook projections are reduced from their free ends towards the legs. Furthermore, it is inherent that the profiles are

located in a narrow side of a rectangular floor panel. Claim 45 also introduces the hook elements formed from the leg, which projects approximately perpendicularly from the narrow side of the panel. Claim 65 indicates that the panel is rectangular therefore, the retaining profiles are in the narrow sides of the rectangular panel.

Claims 5 and 29 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 65, 66, and 71 of U.S. Patent No. 6,505,452 in view of Moriau et al., 6,006,486.

Regarding claim 5, claim 71 of US6,505,452 fails to further include a clearance provided between an end of the hook projections at an underside of a second panel and the narrow side of the first panel, and the end of the hook projection at a top side of the first panel in the assembled condition bears against the second panel at least in the region of the top side of the panel. Moriau et al. teach, in Fig. 8, a clearance **21, 81** provided between an end of the hook projections at an underside of a second panel and the narrow side of the first panel, and the end of the hook projection at a top side of the first panel in the assembled condition bears against the second panel at least in the region of the top side of the panel.

Regarding claim 29, claim 71 of US6,505,452 fails to further limit the material used to comprise the panels. Moriau et al. teach panels made of MDF, HDF, or

chipboard material. Therefore, it would have been obvious to comprise the panels of substantially MDF, HDF, or chipboard material.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1, 2, 4 and 30 are rejected under 35 U.S.C. 102(b) as being anticipated by the French patent, 2,278,876 (see marked-up attachment).

Regarding claim 1, as best understood, the French patent discloses, in unlabeled figure, a fastening system characterized in that retaining surfaces **A1** of hook projections **A2** and complementary hook projections **A5** are inclined. The hook projections **A2** are reduced from free ends **A3** towards legs **A4**. One of the hook projections **A2** bears against the retaining surfaces **A1** of the complementary hook projections **A5**.

Regarding claim 2, as best understood, a first retaining profile of at least one pair of oppositely disposed retaining profiles is provided with a hook element formed from the leg. The leg projects approximately perpendicularly from the narrow side of the panel and arranged at a top side of the panel. A hook projection **A2** is arranged at the free end of the leg. The hook projection faces towards an underside of the panel. A second retaining profile of at least one pair of oppositely disposed retaining profiles is opposite the first retaining profile and provided with a hook element formed from the leg. The leg projects from the narrow side of the panel and arranged at an underside of the panel. A hook projection **A2** is arranged at the free end of the leg of the second retaining profile. The hook projection faces towards the top side of the panel.

Regarding claim 4, as best understood, the retaining surfaces **A1** engage with the complementary hook projections **A5**. Applicant is reminded that the method of engaging the retaining surfaces **A1** with the complementary hook projections **A5** is not germane to the issue of patentability of the device itself. Therefore, this limitation has been given limited patentable weight. See MPEP ' 2113.

Regarding claim 30, the French patent teaches a panel comprising the fastening system according to claim 1 above.

Claims 1, 2 and 4 are rejected under 35 U.S.C. 102(b) as being anticipated by Knipp et al., 5,348,778.

Regarding claim 1, as best understood, Knipp et al. disclose, in Fig. 2, a fastening system characterized in that retaining surfaces **33** of hook projections **32** and complementary hook projections **32** are inclined (col. 3, lines 13-14). The hook projections and the complementary hook projection **32** are reduced from free ends towards legs. One of the hook projections bears against the retaining surfaces of the complementary hook projections.

Regarding claim 2, as best understood, a first retaining profile of at least one pair of oppositely disposed retaining profiles is provided with a hook element formed from the leg. The leg projects approximately perpendicularly from the narrow side of the panel and arranged at a top side of the panel. A hook projection **32** is arranged at the free end of the leg. The hook projection faces towards an underside of the panel. A second retaining profile of at least one pair of oppositely disposed retaining profiles is opposite the first retaining profile and provided with a hook element formed from the leg. The leg projects from the narrow side of the panel and arranged at an underside of the panel. A hook projection **32** is arranged at the free end of the leg of the second retaining profile. The hook projection faces towards the top side of the panel.

Regarding claim 4, as best understood, the retaining surfaces engage with the complementary hook projection **32**. Applicant is reminded that the method of engaging the retaining surface with the complementary hook projection **32** is not germane to the

issue of patentability of the device itself. Therefore, this limitation has been given limited patentable weight. See MPEP ' 2113.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 5 and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over the French patent, 2,278,876, in view of Moriau et al., 6,006,486.

Regarding claim 5, the French patent, as discussed above, discloses the end of the hook projection at a top side of the first panel in the assembled condition bears against the second panel at least in the region of the top side of the panel. However, the French patent fails to disclose a clearance provided between an end of the hook projections at an underside of a second panel and the narrow side of the first panel. Moriau et al. teach, in Fig. 8, a clearance **21, 81** provided between an end of the hook projections at an underside of a second panel and the narrow side of the first panel to act as dust chambers (col. 11, lines 66-67). Therefore, as taught by Moriau et al., it would have been obvious to one of ordinary skill in the art at the time the invention was

made to provide the clearance **21, 81** between an end of the hook projections at the underside of the second panel and the narrow side of the first panel to act as dust chambers to collect dust.

Regarding claim 29, the French patent fails to disclose the panels substantially comprise of an MDF, HDF or chipboard material. Moriau et al. teaches panels 1 substantially comprise of an MDF, HDF or chipboard material as part of a material choice (col. 3, lines 26-37). Therefore, as taught by Moriau et al., it would have been obvious to one of ordinary skill in the art at the time the invention was made to substantially make the panels of an MDF, HDF or chipboard material as part of a material selection.

Response to Arguments

Applicant's arguments filed 6/16/04 have been fully considered but they are not persuasive.

Applicant has argued that the figure provided by the Examiner does not appear in the French publication. Applicant is correct. The examiner merely fabricated what is suggested by the specification (see attachment of the English abstract). It is inherent that several tiles make-up a floor covering. One of ordinary skill in the art will readily know that putting tiles of the French patent together make-up a floor covering as shown

by the Examiner. Furthermore, it is inherent that the profiles interlock with each other as that is their function to interlock tiles.

Applicant has further argued that the French patent does not teach adjacent panels fit tightly together such that a floor assembled from the panels is gap-free. Again, the English abstract indicates “interlocking effect” thus the panels are tightly fitted together. In respect to the gap-free, the English abstract indicates that the surfaces of the panels, when overlapped, are smooth thus no gaps.

Applicant has argued that the French patent fails to teach retaining surfaces. This is not persuasive as the locking elements inherently have a retaining surface. It is the retaining surface that is essential in the French patent in order to interlock the panels.

Allowable Subject Matter

Claims 3, 8, and 31 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

The following is a statement of reasons for the indication of allowable subject matter:

regarding claim 3, the prior art of record does not disclose or suggest a fastening system comprising a clearance provided between a hook projection, at a top side of a second panel, and a leg at an underside of a first panel;

regarding claim 8, this claim depends from claim 3;

regarding claim 31, the prior art of record does not disclose or suggest a fastening system comprising a clearance provided between a hook projection at an underside of a second panel and a leg at an underside of a first panel.

Conclusion

The following prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The French patent, 779,602 shows a similar fastening system as rejected.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. The new limitation "connected to the panels by legs" in line 9 of claim 1 and the removal of the limitation "at least in a region wise manner" in line 16 of claim 1 necessitated the new rejections. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ernesto Garcia whose telephone number is 703-308-8606. The examiner can normally be reached from 9:30-6:00. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9326 for regular communications and 703-872-9327 for After Final communications.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Daniel P. Stodola can be reached on 703-308-2686. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1113.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for

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published applications may be obtained from either Private PAIR or Public PAIR.

Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

E.G.

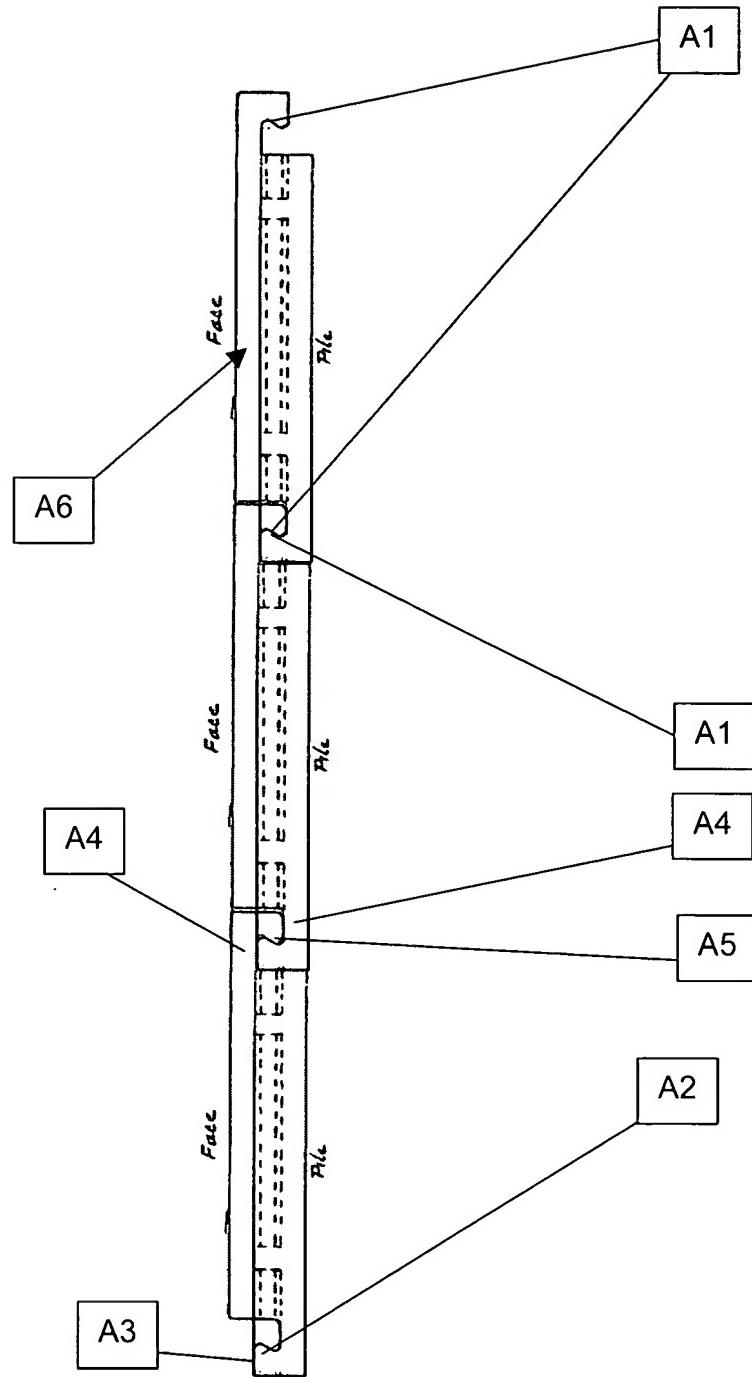
August 24, 2004

Attachment: one marked-up copy of French patent, 2,278,876; and,
one copy of an English abstract of the French patent, 2,278,876.



DANIEL P. STODOLA
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600

FR-2,278,876



Application : 10/019,195
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DERWENT-ACC-NO: 1976-E3313X

DERWENT-WEEK: 197619

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TITLE: Flexible floor covering tile with interlocking edges -
has grooves crossing at corner on each two adjoining
edges

PATENT-ASSIGNEE: CHOPPE R[CHOP]

PRIORITY-DATA: 1973FR-0036040 (October 9, 1973)

PATENT-FAMILY:

PUB-NO	PUB-DATE	LANGUAGE	PAGES	MAIN-IPC
FR 2278876 A	March 19, 1976	N/A	000	N/A

INT-CL (IPC): E04F015/02

ABSTRACTED-PUB-NO: FR 2278876A

BASIC-ABSTRACT:

A floor covering method using tiles which may be of rubber or plastics material, uses superimposed integral tiles with the upper tile offset diagonally on the lower tile, the contact faces of the tiles being designed to give an accurate location without sliding. The contact faces are grooved along two adjacent sides, inset from the edge so as to leave a hooked edge, giving an interlocking effect, the grooves being bridges at two points forming a stop for the other tile edge. This overlapping arrangement enables the surface to be covered in an even, smooth manner.

TITLE-TERMS: FLEXIBLE FLOOR COVER TILE INTERLOCKING EDGE
GROOVE CROSS CORNER
TWO ADJOIN EDGE

DERWENT-CLASS: Q45